

REMARKS

This responds to the Office Action mailed on December 19, 2005.

Claims 22-25 and 32-35 are pending in this application.

§102 Rejection of the Claims

Claims 22-25 and 32-35 were rejected under 35 USC § 102(b) as being anticipated by Rondeau (U.S. 5,850,433).

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.¹ It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*.”²

The Office Action states that the prior art structure is capable of performing the intended use, apparently relying on a theory of inherency. Applicant respectfully disagrees and points out that in order to rely upon a theory of inherency which would support the assertion that Rondeau is capable of performing the intended use, the Office Action must provide a basis in fact and/or technical reasoning to support that such characteristic *necessarily* flows from the teachings of Rondeau.³

Applicant respectfully submits that the Office Action did not make out a *prima facie* case as Rondeau does not teach each and every claim element.

With respect to claim 22, Applicant respectfully points out that the purpose and function of Rondeau do not provide any basis in fact or technical reasoning to support the assertion that Rondeau is capable of performing the intended use and therefore does not anticipate claim 22. Applicant submits that Rondeau does not disclose a “second electronic device to receive a service request..fulfill a portion of the service request...find a third electronic device using the

¹ *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).

² *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

³ See *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

registry server and to send a remaining portion of the service request to the third electronic device.”⁴ Applicant submits that the server 28 in Rondeau is coupled to the database 14, and Applicant fails to find in Rondeau a server, where the “server compris[es] a registry,” as is recited in Claim 22. In contrast, it appears to the Applicant that Rondeau teaches one or more databases 14 coupled to the database server 28.⁵

Additionally, the server 28 in Rondeau responds *completely* to the request for information. In Rondeau, a request is received by a telephony server or a terminal server, the server 28 retrieves information related to the request, and responds to the *entirety of the request*. Further, the electronic devices recited in claim 22 operate in a wholly different manner than the single electronic device disclosed in Rondeau. The electronic device 18 relied upon by the Office Action is a client to the system 12 disclosed in Rondeau. The electronic device requests information over a terminal connection with a terminal server and receives a reply to the information request from the database server 28 relayed by the terminal server 26. Applicant fails to find a third electronic device to respond to a portion of the service request not totally fulfilled by the second electronic device. Further, as pointed out in Applicant’s response of September 16, 2005, Rondeau is a directory service. It appears to the Applicant that the whole purpose of Rondeau is to respond to a request for a directory listing with that directory listing and would be incapable of responding partially to any request. The Office Action fails to provide any basis that Rondeau is capable of performing the functions described in claim 22, other than a one sentence assertion that Rondeau anticipates claim 22.

With respect to claim 32, Applicant submits that the network adapter 32 relied upon the Office Action is not a network adapter as contemplated in claim 32. The network adapter 32 in Rondeau is in actuality a Local Area Network.⁶

With respect to the claims that properly depend from the above mentioned independent claims, Applicant respectfully submits that a dependent claim incorporates the claim elements of the independent claim from which it properly depends. Applicant respectfully submits that claims 22-25 and 32-35 are allowable over Rondeau for at least the reasons stated above.

⁴ Independent Claim 22.

⁵ See Rondeau, Col. 6, Lines 14-28.

⁶ “interconnected with one another over a local area network (LAN) 32. Rondeau, Col. 5, Lines 17-18.

Comments with respect to Applicant's Response of September 16, 2005

Applicant submits that the electronic device 18 of Rondeau is not capable of receiving a service request from another device and finding yet another device as the Office Action states in response to Applicant's argument of September 16, 2005. The electronic device 18 of Rondeau is a terminal client coupled to a terminal server 26. The terminal server 26 provides limited terminal functionality to the terminal client 18. The terminal server 26 of Rondeau communicates with the terminal client 18 over a Point-to-Point (PPP) protocol, not a native Internet Protocol (IP).⁷ The terminal client is not capable of communicating with any other device, except through the terminal server 26. The service request, if one was directed towards the electronic device 18, which Applicant submits is not disclosed in Rondeau in any way, would be received by the terminal server 26, which would then pass it to the terminal client.

Applicant respectfully disagrees with the Office Action that Rondeau is capable of performing the functions of the present claims. Applicant submits that the systems of Rondeau are capable of performing a single function, that is to respond to a directory service look-up with a directory entry. In the case of a request received by the telephony server 30, a telephone call is initiated. One example of this would be a 411 call on a PSTN that is handled by an automated system. In no way is such system able to respond to just a portion of that request.

Applicant again points out that there must be some basis in fact and/or technical reasoning in the Office Action to support the assertion that Rondeau is capable of performing the functions recited. Applicant respectfully submits that the Office Action has failed to do so, and requests the withdrawal of the rejection and allowance of claims 22-25 and 32-35.

⁷ See Rondeau, Col. 5, Lines 35-45.

AMENDMENT UNDER 37 C.F.R. 1.116 – EXPEDITED PROCEDURE

Serial Number: 10/027,440

Filing Date: December 20, 2001

Title: ALGORITHM FOR WEB SERVICES FULFILLMENT IN A PEER-TO-PEER ENVIRONMENT

Assignee: Intel Corporation

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Dkt: 884.623US1 (INTEL)

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 612-371-2159 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

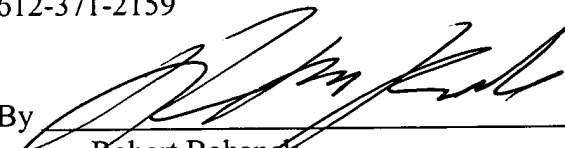
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2/21/01

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 21st day of February, 2006.

Name

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